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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/724,282	11/26/2003	Thomas Wien	11286-01250	1147

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EXAMINER


PURVIS, SUE A

ART UNIT PAPER NUMBER

1734

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/724,282	Applicant(s) WIEN ET AL.	
	Examiner Sue A. Purvis	Art Unit 1734	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 231-290 is/are pending in the application.
4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 250-263, 279, 281 and 282 is/are allowed.
- 6) ☒ Claim(s) 231-249, 264-278, 280 and 283-290 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|--|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 231-247 and 263-270 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for applying a label to a CD (or article), does not reasonably provide enablement for an article to be alternatively pressed down on first and second labels. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. It is clear from the drawings and the specification how an article of CD can be labeled, however it is unclear how the article can be labeled by alternative first & second labels when in the label application position. There seems to be only one label application position and only one way to label an article. Clarification is required.

3. Claims 271-278 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The examiner was unable find sufficient description of the "centering ring" as set forth in claims 271 and 272. Clarification is required.

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4. Claims 283-290 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claims contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventors, at the time the application was filed, had possession of the claimed invention. The examiner was unable find sufficient description of the "locator assembly" and "lift post" as set forth in claims 283 through 290. Clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 248 and 249 are rejected under 35 U.S.C. 102(b) as being anticipated by Hummell et al. (US Patent No. 5,951,819).

Hummell et al. discloses a labeling device for labeling various optical disks, including CDs and DVDs. The device includes a label support surface (21); a post means (30) extending up from a central area of the label support surface for centering a label; centering means (28) positionable by a user between an operative position and an inoperative position; and the post means including article support means (38) for supporting an article in a position such that articles can be pressed down and against the adhesive face the labels.

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Regarding applicant's use of "first & second labels" in the claim, this is considered to material worked upon by the examiner and does not affect the structure of the device. (See MPEP §2115.)

Regarding claim 249, the centering means (28) extends below the label support surface as shown in Figure 4.

7. Claims 271, 273, 274, and 278 are rejected under 35 U.S.C. 102(e) as being anticipated by Hummell et al. (US Patent No. 6,660,113 B2).

Hummell discloses a label applicator including a label support surface (24); a label application post assembly (30) at a central area of the support surface; the post assembly including an outer centering ring (36, 38) movable in an opening in the support surface; the post assembly further including a centering post (32) and a spindle (66) fixed to the centering post and extending up from a top surface thereof, the outer centering ring being concentric with the centering post; and a support ledge defined by the top surface of the centering post. (See Figures 1 and 2.)

Regarding claims 273 and 274, the centering ring (36, 38) is biased with a spring (94).

8. Claims 280 are rejected under 35 U.S.C. 102(e) as being anticipated by Koch (US Patent No. 6,347,654 B1).

Koch discloses a label support surface (14) with a central area (15), a post assembly (24) extending up from the central area. The CD and label are guided together as seen in Figures 1 and 4. The surface includes a plurality of flex ribs (16) with at least a pair at the longitudinal edges of the support area.

Allowable Subject Matter

9. Claims 250-263, 279, 281, and 282 are allowed.

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10. The following is an examiner's statement of reasons for allowance:

- a. Regarding claims 250-263, prior art does not teach using a label applicator with first & second pairs of engagement members which engage the label tabs. Barnet (US Patent No. 6,689,238 B2) discloses a single peg as an engagement member, but there is no reason or suggestion for using a pair of engagement members as required by the claim.
- b. Regarding claim 279, prior art does not teach or suggest using a flat spring and a coil spring.
- c. Regarding claim 281, prior art does not teach or suggest surface flaps having a foam portion at the opening and compressible against the support surface in a label applicator as set forth in the claim.
- d. Regarding claim 282, prior art does not teach or suggest a label applicator as defined in claim 282 where a post assembly includes a ring coupled to a foam sleeve and a cap capable of being screwed into and out of the foam sleeve.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."


Conclusion

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sue A. Purvis whose telephone number is (571) 272-1236. The examiner can normally be reached on Monday through Friday 9am to 6pm.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rick Crispino can be reached on (571) 272-1226. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Sue A. Purvis
Primary Examiner
Art Unit 1734

SP
June 12, 2004